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| APPLICATION NO.                     | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/072,647                          | 02/06/2002  | Timothy Tianyi Chen  | 0264-1              | 3268             |
| 25901                               | 7590        | 12/19/2008           |                     |                  |
| ERNEST D. BUFF                      |             |                      | EXAMINER            |                  |
| ERNEST D. BUFF AND ASSOCIATES, LLC. |             |                      | CARLSON, JEFFREY D  |                  |
| 231 SOMERVILLE ROAD                 |             |                      |                     |                  |
| BEDMINSTER, NJ 07921                |             |                      | ART UNIT            | PAPER NUMBER     |
|                                     |             |                      | 3622                |                  |
|                                     |             |                      | MAIL DATE           | DELIVERY MODE    |
|                                     |             |                      | 12/19/2008          | PAPER            |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/072,647

**Applicant(s)**

CHEN, TIMOTHY TIANYI

**Examiner**

Jeffrey D. Carlson

**Art Unit**

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### DETAILED ACTION

1. This action is responsive to the papers filed 9/29/2008.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 103 that form the basis for the rejections under this section made in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over van der Riet (US7158943) in view of Hohle et al (US20020046116).**

Van der Riet enjoys the benefit of earlier filed provisional application 60/316268. Regarding claims 1-4, 11-13, van der Riet teaches a system that creates user profiles by tracking consumer activity, presents retailers' advertising targeted to users based on their profiles, provides loyalty rewards to users for enabling their shopping to be tracked after exposure to an advertisement [pg 8 claim 2, pg 6 #13 of 60/316268], and calculates advertising effectiveness for the retailers according to ad exposure and associated purchasing [pg 8 claim 4 of 60/316268]. 60/316268 by van der Riet does not appear to teach tracking of *offline* purchasing as a means to further develop the user profile, nor is a physical card taught as a means of tracking loyalty. van der Riet does however teach identification of consumers and tracking of their purchase histories and behaviors (holistic consumer profiles) and delivery of targeted advertising to them according to those identified/matched profiles [pg 5 – "key ideas" of 60/316268].

Consumers are rewarded for the use of their holistic profiles by personalized ad-based information – “best compared with that of an activity based loyalty point system” [pg 6 #13, pg 9, #9 of 60/316268]. While van der Riet teaches what amounts to loyalty profiles and a loyalty system for online retailers, there is no mention of a loyalty identification card used in the offline retail locations. Hohle et al teaches the use of identification/loyalty cards *for online and offline* purchasing in a loyalty system [0027]. It would have been obvious to one of ordinary skill at the time of the invention to have used any type of identification card including those described by Hohle et al so that unique identified consumer profiles of van der Riet can also include offline purchasing tied to the identified consumer ) be uniquely associated and tracked as desired. One of ordinary skill would recognize that this would provide more accurate user profiles, leading to more effective targeted advertising and would enable customers to earn loyalty rewards for online and offline consumer activities.

Regarding claim 5, it is inherent that the on-going operation of van der Riet includes repeated targeting of effective ads.

Regarding claims 6, 14, the ability to measure the effectiveness for an ad in association with purchase data is taken to include at least capture of the item purchased in the consumer transactions.

Regarding claims 9, 10, the system of van der Riet is capable of serving many different retailers and is taken to be an third party/administrator system. The ads are stored in ad database in association with retailer-defined criteria [13:27-29].

Regarding claims 7, 8, van der Riet teaches that targeted advertising can be sent to the consumers anywhere, anytime via their PC [15:15-16], yet van der Riet does not appear to mention the use of email. Official Notice is taken that it is well known for online shopping/advertising systems to include capture of user's email addresses upon registration so that advertising and offers can be sent to the user via email. It would have been obvious to one of ordinary skill at the time of the invention to have communicated the targeted advertising of van der Riet to users using email, as this is a cheap and efficient means of delivering text/image-based advertising and offers.

Regarding claim 15, Hohle et al teaches that the identification card technology may include barcode technology [0028]. Further, Official Notice is taken that magnetic stripe cards and as well as uniquely-assigned drivers licenses are typically used as loyalty cards and it would have been obvious to one of ordinary skill at the time of the invention to have provided either as a means of identifying the consumer.

### ***Response to Arguments***

Applicant is incorrect when he states that "the rejection currently of record uses information that appears for the first time in the Van der Riet patent and therefore does not enjoy priority to the Provisional patent". Examiner referenced columns 5-6 of the patent when he should have referenced the provisional. However, ALL of the disclosure **relied upon** by the examiner from that section was present in the provisional of 60/316268. Examiner was quite clear that the provisional of 60/316268 DOES NOT teach offline loyalty purchasing/tracking and DOES NOT teach a physical card;

Examiner was quite clear that he was not relying on '943 as a teaching for offline loyalty and/or a card. The examiner however concluded that *given the secondary teaching reference of Hohle et al*, that the claimed invention would have been obvious.

Applicant argues that because Van der Riet added offline purchasing history to his provisional, this is evidence of teaching away from such an idea. Examiner disagrees. Silence on a feature is not teaching away. Features are added all the time in non-provisional filings and CIP's; these are not automatically thought to have been previously taught away from such an idea.

Applicant argues that modifying the invention would present an inordinate burden on one of ordinary skill. Examiner disagrees. Applicant argues that retailers would have to buy (and/or develop) saver card software, hardware and usage procedures. The ability to "buy" such a feature is evidence that it is routine. None of these tasks are beyond one of ordinary skill. This is what computer system designers and implementers do all the time. Simply because it takes time and/or money does not equate to non-obviousness and does not equate to extraordinary skill requirements. These are also the types of things Hohle et al is assumed to tackle for his system which offers both online and offline retailer tracking. Further, because the examiner posited an obvious *combination* of references does not mean that one of ordinary skill would have to necessarily modify existing software/hardware of Van der Riet. One of ordinary skill having to motivation to construct the system deemed obvious could also build such a system from scratch without needing to address any challenges related to *retrofitting* an existing system. Therefore, not only is the homologizing believed to be fairly routine

to one of ordinary skill, but unnecessary if a new system was created from day one. In short, cost and time of software/system development and implementation are not dispositive of non obviousness.

### ***Conclusion***

4. This is an RCE and all claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/  
Primary Examiner, Art Unit 3622

Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc